

## REMARKS

### **I. Introduction**

Claims 11 to 13, 15 to 21, 23 and 24 are pending in the present application after the cancellation, without prejudice, of claims 14 and 22 and the addition of new claim 24. In view of the forgoing amendments and the following remarks, it is respectfully submitted that all of the presently pending claims are allowable, and reconsideration is respectfully requested.

As an initial matter, the Office Action Summary does not include an acknowledgment of the claim for foreign priority and does not indicate whether a certified copy of the priority document has been received. A claim for priority to Application No. 102 45 343.8, filed in the Federal Republic of Germany on September 7, 2002, was made, *inter alia*, in the “Declaration and Power of Attorney” filed on September 9, 2005. At least the “Notification of Missing Requirements Under 35 U.S.C. 371 in the United States Designated/Elected Office (DO/EO/US),” dated August 12, 2005 indicates that the priority document has been received by the United States Patent and Trademark Office. Applicants therefore respectfully request acknowledgment of the claim for foreign priority and acknowledgment of receipt of the priority document with the next Office communication.

Applicants thank the Examiner for considering the previously filed Information Disclosure Statement, PTO-1449 papers and cited references.

### **II. Rejections Under 35 U.S.C. §§ 102 and 103**

Claims 11 was rejected under 35 U.S.C. § 102(b) as anticipated by Cheng et al. (U.S. Patent No. 6,007,390). Claims 12 to 23 were rejected under 35 U.S.C. § 103(a) as unpatentable over Cheng et al. It is respectfully submitted that these rejections should be withdrawn for at least the following reasons.

To anticipate a claim, the reference must disclose each and every element of the claimed invention. *Verdergaal Bros. v. Union Oil Co. of Cal.*, 814 F.2d 628, 2 USPQ2d 1051 (Fed. Cir. 1987). Applicants respectfully submit that Cheng et al. do not disclose, or even suggest, all of the features recited in amended independent claim 11.

In order for a claim to be rejected for obviousness under 35 U.S.C. § 103(a), not only must the prior art teach or suggest each element of the claim, but the prior art must also suggest combining the elements in the manner contemplated by the claim. *See Northern Telecom, Inc. v. Datapoint Corp.*, 908 F. 2d 931, 934 (Fed. Cir. 1990), *cert. denied* 111 S.Ct.

296 (1990); *In re Bond*, 910 F. 2d 831, 834 (Fed. Cir. 1990). The Examiner bears the initial burden of establishing a *prima facie* case of obviousness. See M.P.E.P. §2142. To establish a *prima facie* case of obviousness, the Examiner must show, *inter alia*, that there is some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify or combine the references and that, when so modified or combined, the prior art teaches or suggests all of the claim limitations. See M.P.E.P. §2143. Applicant respectfully submits that a *prima facie* case of obviousness has not been established.

Amended claim 11 recites, *inter alia*, an electric contact wherein structuring for a structured layer includes particles dispersed in a matrix, at least some of the dispersed particles having a greater hardness than the matrix and made of at least one of aluminum oxide, zirconium oxide, yttrium oxide, a titanium aluminide, and a ruthenium alloy phase.

Cheng et al. describe an electrically-conductive metal substrate 14 of a terminal 10 having a co-deposited composite coating that includes an electrically-conductive layer 16 of a ceramic such as titanium nitride with particles 18 of a highly conductive and preferably low friction metal such as silver or gold. Column 2, lines 58 to 67; Figure 1B. Particles 18 are located on the surface of the titanium nitride layer 16. Column 2, lines 66 to 67. Nowhere do Cheng et al. disclose dispersed particles having a greater hardness than a matrix whereby the particles are made of at least one of the compounds listed in claim 11.

Amended claim 15 recites, *inter alia*, an electric contact wherein at least some dispersed particles are made of a solid-state lubricant, the solid-state lubricant at least one of graphite and molybdenum disulfide. Cheng et al. do not disclose dispersed particles made of a solid-state lubricant whereby the lubricant is graphite or molybdenum disulfide.

Amended claim 18 recites, *inter alia*, an electric contact wherein a matrix is made of silver or a silver alloy and a dispersion structure is produced electrolytically. Cheng et al. do not disclose any layer containing a matrix made of silver or a silver alloy produced electrolytically. To the contrary, Figure 1B of Cheng et al. show that the matrix of the layer consists of titanium nitride as a ceramic including dispersed metallic particles of silver.

Amended claim 19 recites, *inter alia*, an electric contact wherein a structured layer is formed by a multilayer system which is made up of successive layers having different chemical compositions, the multilayer system including layers of indium and silver. Cheng et al. do not disclose any multilayer system at all, particularly no multilayer system containing layers of indium and silver.

Amended claim 20 recites, *inter alia*, an electric contact wherein at least some area of a contact layer has a noble metal cover layer which is made of one of gold, silver, platinum, ruthenium, palladium, or an alloy of these elements. Cheng et al. do not disclose any cover layer made out of one of the metals featured in claim 20.

Because Cheng et al. fail to disclose all of the features of amended claims 11, 15 and 18 to 20, Applicants respectfully submit that these claims are patentable over Cheng et al.

As for claims 12, 13, 16, 17, 21 and 23, which ultimately depend from claim 11 and therefore include all of the features recited in claim 11, it is respectfully submitted that Cheng et al. do not render unpatentable these dependent claims for at least the same reasons more fully set forth above in support of the patentability of claim 11.

Accordingly, Applicants respectfully submit that all rejection raised under 35 U.S.C. §§ 102 and 103 should be withdrawn.

### **III. New Claim 24**

New independent claim 24 has been added herein. It is respectfully submitted that new claim 24 adds no new matter and is fully supported by the present application, including the Specification. *See, e.g.*, Substitute Specification, page 6, lines 24 to 30. It is respectfully submitted that claim 24 is patentable over the reference relied upon for at least the reason that the reference relied upon does not disclose, or even suggest, a method of manufacturing an electric contact that includes applying a contact layer to a substrate by an electrolytic method, the contact layer having a thickness between 1  $\mu\text{m}$  and 3  $\mu\text{m}$  and a matrix made of tin wherein particles of aluminum oxide having a size between 20 nm and 200 nm are dispersed in the matrix.

**IV. Conclusion**

In light of the foregoing, Applicants respectfully submit that all pending claims are in condition for allowance. Prompt reconsideration and allowance of the present application are therefore earnestly solicited.

Respectfully submitted,

Dated: *August 7, 2006* By:

  
Gerard A. Messina  
Reg. No. 35,952

R.N.  
*421194*

KENYON & KENYON LLP  
One Broadway  
New York, NY 10004  
Telephone: (212) 425-7200  
Facsimile: (212) 425-5288  
**CUSTOMER NO. 26646**